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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/240,895 05/11/94 COMISKEY

S 17234

EXAMINER

MACHOLL, M

ART UNIT

PAPER NUMBER

15M2/1018

NIXON & VANDERHYE
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1513

DATE MAILED:

10/18/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS☒ This application has been examined ☒ Responsive to communication filed on 08/05/94 ☒ This action is made final.A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION1. ☒ Claims 1-20 are pending in the application.Of the above, claims 3-5, 14, 15 and 20 are withdrawn from consideration.2. ☐ Claims _____ have been cancelled.3. ☐ Claims _____ are allowed.4. ☒ Claims 1, 2, 6-13 and 16-19 are rejected.5. ☐ Claims _____ are objected to.6. ☐ Claims _____ are subject to restriction or election requirement.7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.8. ☐ Formal drawings are required in response to this Office action.9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings
are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the
examiner; ☐ disapproved by the examiner (see explanation).11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in
accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.14. ☐ Other**EXAMINER'S ACTION**

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1. This Office Action is in response to Applicants' Amendment and Remarks received 08/05/94 (Paper No. 6).

Claims 3-5, 14, 15 and 20 stand withdrawn from consideration by the examiner as being drawn to non-elected species.

2. The application stands objected to because of alterations which have not been initialed and dated as is required by 37 CFR 1.152(c) and 1.56. Applicants state, in Paper No. 6, that the only handwritten changes are those made to figure 8, but that the drawings are informal drawings.

The specification, page 5, contains uninitialed, undated alterations. Although the changes are of a typographical nature, they still need to be accounted for.

3. Claims 1, 2, 6-13 and 16-19 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: The phrase "location...at which...light is likely to be reflected" is vague and indefinite. Is there any difference in location for reflection of direct light vs. reflection of indirect light?

Claim 2: The phrase "substantially eliminate reflection" is unclear. How much light could be reflected and still be

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considered to be substantially eliminated? Is it possible for direct light to be reflected but not indirect light or vice versa?

Claims 9 and 19: The limitation regarding size in compliance with regulations is indefinite. The examiner notes that claim 8 was amended to remove this indefinite limitation but claims 9 and 19 were not.

Claim 9, as amended, ends with the phrase "with the letters or logo." Should something be added after this phrase, or should the phrase also be deleted?

Claims 9 and 10: It is unclear if the phrase "primarily black or dark colored" places any limitation with respect to amount of area. Applicants state that the "primarily black" language was removed from claim 9. However, applicants' amendment requested no such deletion.

Claim 10: How much is "most" of the light?

Claim 17: The limitation of "dimensioned to substantially cover the area" is indefinite. The area to be covered will vary with the size of the person.

The limitation of "sufficient to substantially eliminate" is unclear. (See related comments for claim 2.)

Applicants' arguments presented in Paper No. 6 have been fully considered but are not deemed to be persuasive.

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With respect to the limitation of "direct or indirect" light, applicants state that this merely refers to all light. If so, why not remove the phrase "direct or indirect" from the claims. The present claims could reasonably be interpreted to require covering a location at which direct light is likely to be reflected or covering a location at which indirect light is likely to be reflected. Whether or not these locations would be the same is uncertain.

With respect to the term "substantially", while it is true that the term appears in numerous patents, it is the examiner's position that the definiteness and clarity of the term must be considered in the context in which it is used. The examiner maintains the position that the phrase "substantially eliminate(s) reflection" is unclear because the claims using this terminology do not clearly set forth how much light is allowed to be reflected and still be within the scope of substantially eliminating reflection.

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which

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the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 1, 2 and 8-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the conventional use of eye black by athletes for the reasons of record in Paper No. 5.

Applicants' arguments, as presented in Paper No. 6, have been fully considered but are not deemed to be persuasive. Applicants argue that it "is impermissible to ignore the language 'predefined clearly demarcated geometric shape'..." and that "the terms may not be dissected individually...". Applicants argue that the claims are to be given their broadest reasonable interpretation, with emphasis on "reasonable".

The examiner points out that the "predefined clearly demarcated geometric shape" language was not ignored when making the rejection of record. The terms of the phrase, taken individually or as a whole, do not patentably distinguish claims 1, 2 and 8-12 of the present invention from the conventional use of eye black. It is the examiner's position that the only positive limitation imposed by this language is that where the shape begins and ends is clearly visible.

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Applicants' enclose the Webster's Dictionary definition of "predefined". The examiner notes that, as defined in Webster's, there is no time limitation as to "predefined". That is, if one decides one minute, one hour, or one year in advance as to the shape of the design, the shape has been predefined.

The examiner maintains the position that the application of the material in the shape of a logo, team name, mascot, or letters identifying a manufacturer or distributor is a design choice. The function achieved by using such shapes, i.e. identification of a team, manufacturer or distributor, is inherent in the use of the shape and is well-known. For instance, a company's trademarked logo is used by the company so that consumers can readily identify the company and product associated with the logo. The use of the material in the shape of a logo, team name, mascot or letters does not affect the non-reflectivity function of the material *per se*.

6. Claims 1, 2, 6-13 and 16-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over conventional temporary tattoos as exemplified by the Team Dynamics, J.B. Marketing, Inc., and Anderson's brochures supplied with applicants' Information Disclosure filed 05/11/94 as set forth in Paper No. 5.

Applicants' arguments, as presented in Paper No. 6, have been fully considered but are not deemed to be persuasive.

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Applicants argue that the temporary tattoos are typically not dull, matte, non-reflective and are not dimensioned or positioned so as to cover the area of reflective light location on a wearer's cheek.

Applicants statements regarding the appearance of real tattoos and association with "low class and/or motorcycle gang individuals" has been considered but is not persuasive with respect to the patentability of the present invention.

Applicants argue that one cannot ignore the references' statement regarding application near the eye.

Applicants argue that the examiner's statement, that the references show temporary tattoos applied as close to the eyes as would be applied in the present invention, is erroneous. The examiner maintains this position. The examiner did not state that the tattoos were applied in the same area, but that they were as close to the eyes. That is, a tattoo applied one-half inch to the side of the eye is as close to the eye as a tattoo applied one-half inch below the eye.

As stated in the previous Office action, the intended use of the temporary tattoo of claims 17-19 does not patentably distinguish the claimed tattoo from known tattoos. With respect to the limitations regarding size, reflectivity and dimensions so as to substantially eliminate reflection and to substantially cover a reflective location, the examiner has held these

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limitations to be indefinite for the reasons set forth in the preceding rejection of the claims under 35 U.S.C. 112, second paragraph.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

8. **Crystal Mall 1 Fax Center**

The telecopier numbers for accessing the Crystal Mall I facsimile machine are (703) 305-3596 and (703) 305-3612. This location should be used in all instances when faxing any correspondence to Group 150 in order to facilitate rapid delivery of the materials to the Group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989).

9. Any inquiry concerning this communication should be directed to Marie R. Macholl at telephone number (703) 308-4413. The examiner can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday-Thursday and on alternate Fridays.

MRM
M. Macholl
10/17/94

Mr
PATRICK J. RYAN
SUPERVISORY PATENT EXAMINER
GROUP 1500